

- 22 -

REMARKS

This invention relates to polycyclic nucleotide xanthine phosphofuryltsdr V inhibitors, processes for their preparation and uses to treat various disease states.

This Amendment cancels claims 1, 24-26, 31-33 and 40 without prejudice and adds claims with claims 43 and 44. Support for claims 43 and 44 is found primarily in claims 1 and 40 which they replace, with support for the group  $-C(R^{23})(R^{24})N(H)-$  being found on page 20, line 10 of the specification. As the changes made to these claims is editorial and does not change the substance of the claimed subject matter, no new matter is added and the application of the doctrine of equivalents is not affected. Claims 24-26 and 31-33 are being cancelled without prejudice in order to expedite prosecution and Applicants reserve the right to pursue the cancelled subject matter in a continuing application. Claims 2, 4, 6, 9, 11, 12, 22, 23, 27, 34, 35, 39, 41 and 42 have been changed to depend from new claim 43; as this change does not affect their scope, the application of the doctrine of equivalence is not affected.

Authorization

As this Amendment is filed before the due date of the outstanding Office Action, no fee is believed necessary. However, should such fee become necessary to render this Amendment timely filed or to allow entry of the Amendment, the Commissioner is authorized to draw the required amount from Applicants' deposit account no. 19-0365.

Claim 31 stands rejected for allegedly being indefinite under 35 USC 112, second paragraph. In view of the cancellation of this claim, it is urged that this rejection is moot and should be withdrawn. Applicants have cancelled this claim not because they agree with the rejection, but rather in order to advance prosecution;

- 23 -

Applicants urge that this claim is not indefinite. Applicants reserve the right to pursue this claim in a continuation application.

Claims 1 to 12, 24 to 35, 37 and 39 to 41 stand rejected for allegedly being unpatentable under 35 USC 112, second paragraph, for allegedly being indefinite. In view of the changes to the claims or for the reasons that follow, reconsideration and withdrawal of this rejection is respectfully requested.

Regarding points 1 and 2, the amendments to the claims resolves these issues.

With respect to "thioalkyl" it is urged that this definition is definite in view of the specification and one would infer that the term refers to the group that the rejection terms "mercaptoalkyl". Accordingly, withdrawal of this objection is requested.

Through out the definition section it is clear that the second group is the one onto which the first group is substituted. For example the term "hydroxyalkyl" is defined on page 13 as "a substituted hydrocarbon chain, preferably, an alkyl group, having at least one hydroxyl substituent" and the term "alkoxy" is defined as "an oxygen atom bonded to a hydrocarbon chain, such as an alkyl or alkenyl group." See also the definitions for "carboxylalkyl", "aminoalkyl" and "alkylamino". Thus, in view of the foregoing, it is clear that "thioalkyl" refers to an alkyl group that is substituted with a thio group.

With respect to point 4, Applicants have amended the claims following the helpful suggestion made by the Examiner.

With respect to point 5, Applicants urge that the meaning to the structures is that they are alternative definitions for R<sup>50</sup>, R<sup>51</sup> and R<sup>52</sup> because of the use of the conjunction "or". While it is urged that use of the term "or" prevents having the situation where one has a definition including a narrower range within the definition, Applicants will consider putting the structures in a dependent claim if requested.

- 24 -

The term "ester" is defined on page 14 is defined in the specification on page 14, lines 17 and 18, as a group such as -COO-aryl. It is urged that in view of this definition, the term "ester" may be a substituent.

For the reasons that follow, Applicants urge that the formula is not problematic, as alleged in point 8.

The Examiner urges that the material in the parentheses is not correct because there only be three bonds to carbon contained in the parentheses. However, it should be noted that R<sup>11</sup> and R<sup>12</sup> can supply the missing substituent and may be, for example, the groups recited for R<sup>9</sup>. Hence, it is urged that this structure is complete.

With respect to point 10, Applicants believe that the "or" is correct because one could form a bi-cyclic ring system where the heteroatom is included. However, if the Examiner still disagrees, further clarification of this issue is requested.

In view of the foregoing, reconsideration and withdrawal of this rejection is earnestly solicited.

Claim 40 stands rejected under 35 USC 112, second paragraph, for allegedly being indefinite. In view of new claim 43, reconsideration and withdrawal of this rejection is requested

While Applicants urge that the claim is understandable, they have replaced the term "alkyl halide" with "L-halide" and the term "alkylation" with "reacting" to avoid the potential for any confusion. In view of these changes, it is urged that this rejection is overcome and its withdrawal is earnestly solicited.

Claims 31 and 32 stand rejected under 35 USC 112, first paragraph, for allegedly not complying with the enablement requirement. The cancellation of these claims renders this rejection moot. Again, Applicants have cancelled these claims in order to advance prosecution and not because they agree with the reasons

- 25 -

advanced by the Examiner. Applicants reserve the right to pursue these claims in a continuation application.

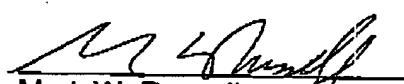
Claims 1 to 12, 22 to 29, 41 and 42 stand rejection under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 11 of US 6,821,978. Applicants intend to file a certificate of correction in order to remove tetrahydropyranyl form claims 10 and 11 of said US patent.

It is believed that this application is now in condition for allowance and an early notice to that effect is earnestly solicited. If, however, there remains an issue outstanding, the Examiner is invited to contact the undersigned for its prompt resolution.

Favorable action is earnestly solicited.

1 September 2005  
Date

Respectfully submitted,



Mark W. Russell  
Registration No. 37,514  
Attorney for Applicants  
Tel: 908-298-5024  
Fax: 908-298-5388

1